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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,069	01/27/2005	Atsushi Tanno	OGW-0353	8379

7590 09/28/2007
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EXAMINER

BELLINGER, JASON R

ART UNIT	PAPER NUMBER
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3617

MAIL DATE	DELIVERY MODE
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09/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,069

Applicant(s)

TANNO, ATSUSHI

Examiner

Jason R. Bellinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Drawings

1. The drawings were received on 16 July 2007. These drawings are approved.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite due to the fact that it is unclear what element of the invention is actually being claimed by the phrase "the inner side" of the wheel. No directional indicators (i.e. axially, radially, inboard, outboard, etc.) have been provided to clearly define this limitation.

4. Claim 1 recites the limitation "radially inward rim flange" in line 8. There is insufficient antecedent basis for this limitation in the claim. First, this limitation has not been previously set forth in the claim. Second, it is unclear whether this "radially inward rim flange" is the same as either the left or right annular rim flanges, or is an additional element of the invention. Third, it is unclear what is actually being claimed by this limitation.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atwell, Jr. In Figures 4 and 4A, Atwell, Jr. shows a disk wheel 10 with a rim 16 located at the peripheral edge of the disk 14. The rim 16 includes left and right bead seats with a protruding hump and radially outwardly extending flanges. As best understood, a ring-like element 18 extends from the inner side of the rim 16, and is located between the hump and rim flange. The wheel is a lightweight wheel 10, formed from an aluminum or magnesium alloy.

Atwell, Jr. does not specify that the cross-sectional area of the element 18 is 0.1-0.4 times larger than the cross-sectional area of the thickness of the rim flange plus the width-wise length of the bead seat multiplied by the thickness of the rim adjacent the hump. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the ring-like element of Atwell, Jr. with a thickness sufficient to prevent the weight 26 from being dislodged during operation, and to serve as a reinforcing rib to distribute forces imparted on the rim.

Response to Arguments

7. Applicant's arguments filed 16 July 2007 have been fully considered but they are not persuasive. The Applicant argues that there would be not motivation to form the ring

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element of Atwell, Jr. with a cross-sectional area of 0.1-4.0 times that of the thickness of the rim flange plus the width-wise length of the bead seat multiplied by the thickness of the rim adjacent the hump, "because Atwell, Jr. merely requires that the flange 18 or 20 be capable of being gripped by the tang 38." The Applicant then argues: "no significance is provided in Atwell, Jr. for achieving a thickness in the specified range, absent Applicant's teachings."

First, it should be noted that the Applicant has not provided any evidence (in the form of declarations or affidavits under 35 USC 1.131 or 1.132) proving the criticality and/or non-obviousness of this feature.

Second, the Supreme Court's decision rendered in *KSR International Co. v. Teleflex, Inc.* (550 U.S. ___, 82 USPQ2d 1385 (April 30, 2007)) has foreclosed the need for motivation to be found in the prior art references themselves. Furthermore, the rationale for arriving at the conclusion of obvious set forth in the rejection above falls under the precept of application of a known technique to a known device ready for improvement to yield predictable results.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 571-272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason R Bellinger
Primary Examiner
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A handwritten signature in black ink, appearing to read 'JRB', is written over the printed name and title of the examiner.